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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/436,882	11/09/1999	DON A. VAN DYKE	0100.9900960	7260

7590

12/16/2002

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EXAMINER

TREAT, WILLIAM M

ART UNIT

PAPER NUMBER

2183

DATE MAILED: 12/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/436,882

Applicant(s)

Van Dyke

Examiner

W. TREAT

Group Art Unit

2143

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3(three) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

☒ Responsive to communication(s) filed on 10/7/02

☒ This action is **FINAL**.

- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

☒ Claim(s) 1-6, 8-13, 15, and 17-18 is/are pending in the application.

Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-6, 8-13, 15, and 17-18 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
  - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

Art Unit: 2183

1. Claims 1-6, 8-13, 15, and 17-18 are presented for examination.
2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-6, 8-13, 15, and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guttag et al. (Patent No. 6,173,394) in view of applicant's specification.
4. The rejection and arguments presented in the examiner's previous action (Paper No. 3, mailed 7/1/02) continue and are hereby incorporated by reference. Since applicants have merely reshuffled their original claim elements without introducing any new claim limitations, the examiner will merely respond to their arguments.
5. Applicants have argued (a) Guttag does not teach when executing a native instruction which is emulating a non-native instruction determining if a flag-

Art Unit: 2183

modification-enable bit prevents modification of a flag, and (b) there is no support for a motivation to combine Guttag's teachings with the prior art knowledge taught by applicants' specification.

6. Clearly, Guttag taught a flag-modification-enable bit in an instruction, and clearly, applicants taught it was known prior art to use RISC instructions to emulate variable length X86 instructions (see the examiner's previous action). Applicants also pointed out in the Background of the Invention that those familiar with the prior art recognized that the emulation instructions can corrupt flags by their execution that are needed for the execution of subsequent instructions (i.e., there was a need to decouple the handling of the flags from the instruction type). The prior art cited in applicants' specification taught the problem which needed to be solved, and Guttag taught the solution for the problem. That is all the motivation one of ordinary skill needs.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 2183

8. Claims 1-6, 10-13, and 15 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Favor (WO 97/13194).

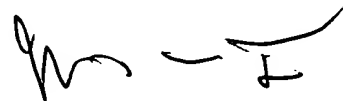
9. The examiner would recommend that applicants read page 35, line 1 through page 38, line 11, at a minimum, before responding. The examiner also views applicants other claims as being clearly anticipated by Favor but has avoided making such a rejection to preclude unnecessary prolongation of the prosecution. Also, the examiner considers his first rejection citing Gutttag in view of applicants' specification to be a totally valid rejection of applicants' current claim language.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 2183

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William M. Treat whose telephone number is (703) 305-9699. The examiner is part of a pilot work-at-home project in which he works from home one day each week, and he works a flexible schedule, but he can normally be reached during the afternoons and evenings on four of the five weekdays.

A handwritten signature in black ink, appearing to read 'Wm - T', located above the printed name.

**WILLIAM M. TREAT  
PRIMARY EXAMINER**